

REMARKS

The Official Action mailed October 30, 2008, has been received and its contents carefully noted. Filed concurrently herewith is a *Request for One Month Extension of Time*, which extends the shortened statutory period for response to February 28, 2009. Accordingly, the Applicant respectfully submits that this response is being timely filed.

The Applicant notes with appreciation the consideration of the Information Disclosure Statements filed on August 1, 2006, and July 24, 2007, and apparent consideration of the Information Disclosure Statement filed October 22, 2007 (paragraph 1 of the Official Action). However, the Applicant notes that the Information Disclosure Statement filed on October 22, 2007 (received by OIPE October 24, 2007) does not include the phrase "All references considered except where lined through" along with the examiner's electronic initials. Therefore, the Applicant respectfully requests that the Examiner provide a copy of the Form PTO-1449 evidencing consideration of the above-referenced Information Disclosure Statement by including the phrase "All references considered except where lined through" In order to ensure there is no confusion as to the status of these references.

Claims 1-17 are pending in the present application, of which claims 1-12 are independent. Paragraph 3 of the Official Action asserts that the claim language is awkward and requests that the claims be proofread to ensure that the translation from Japanese is correct. Claims 1, 3, 5, 7, 9, 11, 13 and 14 have been amended herewith to better recite the features of the present invention and are believed to be in idiomatic English. Support for the present amendments can be found in at least paragraphs [0008]-[0010] of the U.S. Patent Publication of the subject application, 2008/0144374. Claims 2, 4, 6, 8, 10 and 12 have been withdrawn from consideration. Accordingly, claims 1, 3, 5, 7, 9, 11, 13-17 are currently elected and subject to examination, of which claims 1, 3, 5, 7, 9 and 11 are independent. For the reasons set forth in detail below, all

claims are believed to be in condition for allowance. Favorable reconsideration is requested.

Paragraph 5 of the Official Action rejects claims 1, 3, 5, 7 and 13-17 as anticipated by U.S. Patent No. 7,188,282 to Walmsley. Paragraph 7 of the Official Action rejects claims 9 and 11 as obvious based on the combination of Walmsley and admitted prior art (APA). For the reasons described in more detail below, the Applicant respectfully submits that an anticipation rejection cannot be maintained against independent claims 1, 3, 5, and 7 of the present application, as amended, and that a *prima facie* case of obviousness cannot be maintained against independent claims 9 and 11 of the present application, as amended.

As stated in MPEP § 2131, to establish an anticipation rejection, each and every element as set forth in the claim must be described either expressly or inherently in a single prior art reference. Verdegaal Bros. v. Union Oil Co. of California, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987). Furthermore, as stated in MPEP §§ 2142-2143.01, to establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some reason, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. Obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some reason to do so found either explicitly or implicitly in the references themselves or in the knowledge generally available to one of ordinary skill in the art. "The test for an implicit showing is what the combined teachings, knowledge of one of ordinary skill in the art, and the nature of the problem to be solved as a whole would have suggested to those of ordinary skill in the art." In re Kotzab, 217 F.3d 1365, 1370, 55 USPQ2d 1313, 1317 (Fed. Cir. 2000). See also In re Fine, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988); In re Jones, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992).

The prior art, either alone or in combination, does not teach or suggest all the features of the independent claims, as amended. For the reasons provided below, Walmsley and the alleged APA, either alone or in combination, do not teach or suggest the above-referenced features of the present invention.

The Official Action asserts that Walmsley discloses a nonvolatile memory comprising a pair of memory elements as a unit that can transit only from a first state to a second state that are different in electric characteristics (threshold voltage or charge) by applying at least a voltage or a current, wherein a memory cell is formed that stores 1-bit data by using two states that one memory element is in the first state (bit) and the other memory element is in the second state (inverse-bit) and one bit data is stored using two bits (4 states).

However, the Applicant respectfully submits that Walmsley does not teach the following features of the amended independent claims, either explicitly or inherently.

1) "each of first and second memory elements has a low state and a high state regarding electric characteristics and can transit only from the low state to the high state by applying at least a voltage or a current, and the memory cell stores 1-bit data by using a (L, H) state that the first memory element is in the low state and the second memory element is in the high state and a (H, L) state that the first memory element is in the high state and the second memory element is in the low state" as claimed in amended claims 1, 3, 5, 7, 9, and 11;

2) "the memory cell stores 1-bit data by using a (L, H) state ...and a (H, L) state ... among the (L, H) state, the (H, L) state, a (L, L) state ..., and a (H, H) state ..."as claimed in amended claims 7 and 11; and

3) "the (L, H) state and the (H, L) state cannot be transited to each other by applying a voltage or a current to at least one of the first memory element and the second memory element" as claimed in amended claims 3, 7, and 11.

Since Walmsley and the APA, taken alone or in combination, do not teach all the elements of the independent claims, either explicitly or inherently, an anticipation

rejection cannot be maintained. Accordingly, reconsideration and withdrawal of the rejections under 35 U.S.C. § 102 and § 103 are in order and respectfully requested.

Should the Examiner believe that anything further would be desirable to place this application in better condition for allowance, the Examiner is invited to contact the undersigned at the telephone number listed below.

Respectfully submitted,



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